



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/272,002 07/08/94 MANARAS

M 184799CHM/JSA
EXAMINER

LUONG, V

ART UNIT PAPER NUMBER

35M1/0716

SWABEY OGILVY RENAULT
MICHEL SOFIA
1981 MCGILL COLLEGE- SUITE 1600
MONTREAL, QUEBEC, CANADA
H3A 2Y3

3502
DATE MAILED:

07/16/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3/15/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-3 are pending in the application.
Of the above, claims 3 ^{is} are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 2 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☒ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit: 3502

1. The Notice of Abandonment of March 26, 1996 is withdrawn in view of applicant's communications filed on March 15, 1996 and October 11, 1995.

2. Applicant's election of the species of Figs. 1-5 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).

3. Claim 3 is withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected species, the requirement has been traversed in Paper No. 5.

4. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as the apparatus and the manual actuating means in claim 1 must be shown or the features cancelled from the claims. No new matter should be entered.

5. The drawings are objected to because each part of the invention such as: (1) the single actuating mechanism and the chain hoist described in lines 14 and 15 of the specification; and (2) the apparatus and the manual actuating means in claim 1 should be designated by a referential numeral. See 37 CFR 1.84. Correction is required.

Art Unit: 3502

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. § 602.01 and 602.02.

7. The oath or declaration is defective because it does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 C.F.R. § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by *specifying the application number, country, day, month and year of its filing.*

8. The disclosure is objected to because of the following informalities: each part of the invention such as: (1) the apparatus in claim 1; and (2) the single actuating mechanism and the chain hoist described in lines 14 and 15 of the specification should be designated by a referential numeral. See 37 CFR 1.84. Appropriate correction is required.

9. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(1). The terms such as

Art Unit: 3502

"a first drive means", "a second drive means", "an output shaft", "a power cut-off means", "actuating means" and "disengagement means", etc., in claim 1 lack clear antecedent basis in the specification. Applicant is urged to use the same numerical order and terminology in the claims and specification.

Correction is required.

11. Claims 1 and 2 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether:

(a) applicant claims an override device *per se*, or a combination of an override device, an apparatus, a motor and an output shaft;

(b) a confusing variety of terms such as "an override device" and "an apparatus" in claim 1 refer to the same or different structures. See MPEP 608.01(o). Applicant is urged to identify each claimed element with reference to Figs. 1-5; and

(c) applicant claims an apparatus (an override device) *per se*, or a process of use.

It is unclear which structure(s) perform the means-plus-function such as "a power cut-off means", "actuating means" and "disengagement means", etc. Note that "if one employs means-plus-function language in a claim, one **must** set forth in the

Art Unit: 3502

specification an adequate disclosure showing what is meant by that language." *In re Donaldson Co., Inc.*, 29 USPQ2d 1845, 1850 (CAFC 1994). Applicant is urged to identify each means-plus-function with reference to Figs. 1-5.

12. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claim 1, as best understood, is rejected under 35 U.S.C. § 102(b) as being anticipated by Stefanatos (Canadian Patent No. 1,165,785).

Assuming *arguendo* that applicant claims an override device *per se*:

Stefanatos teaches an override device for allowing manual operation of an apparatus normally driven by a motor 11, an output shaft 12 driven by said motor 11 comprising a manual

Art Unit: 3502

actuating means 33, a first drive means 17 operated by said actuating means, a second drive means 14 adapted to be driven by said first drive means 17 and to drive the output shaft 12, a power cut-off means 43 adapted to interrupt the power to the motor, and disengagement means 31 operated as applicant claimed. See pages 1-3 of applicant's specification.

On the one hand, applicant's claim 1 is "fully met" by Stefanatos. On the other hand, it has been held that an element is "adapted to" perform a function is not a positive limitation but merely requires an ability to so perform, thus, it does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138 (CCPA 1946).

15. Claim 2 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112 and to include all of the limitations of the base claim and any intervening claims.

16. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hiroshi (gears 5a and 5b), Syntronic (gears 27 and 50), Otterlei (cam 71), Altenschulte et al. (cam 28 and gears 15), Schuder et al. (gears

Serial Number: 08/272,002

-7-

Art Unit: 3502

22 and 62), Mahon et al. (cam 16), Kurosawa (Fig. 3), Everts (gears 28 and 30) are cited.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM ET to 6:00 PM ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Charles Marmor, can be reached on (703) 308-2168. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Luong

June 17, 1996



VINH T. LUONG
PRIMARY EXAMINER
ART UNIT 352